

and 8 read on a hybrid protein having a native MRP1 sequence and a mutated Kir6.2 sequence.

Therefore, the elected Species read on SEQ ID NOs: 1, 4, 6, and 8.

REMARKS

The Examiner's position remains that the claims of the present application can be restricted to distinct inventions as follows:

- Group I: Claims 1-29, 34, 35, 45 and 46, drawn to a hybrid protein consisting essentially of the fusion of a membrane protein with an ion channel; a host cell expressing the hybrid protein; and a kit comprising the hybrid protein;
- Group II: Claims 30, 31, and 33, drawn to a polynucleotide encoding said hybrid protein;
- Group III: Claim 32, drawn to a primer able to amplify the nucleic acid encoding said hybrid protein; and
- Group IV: Claims 36-44, drawn to methods for screening for an agonist or antagonist of said membrane protein.

In addition, the Examiner is also requiring an election of a single disclosed Species for *each* of the following sub-species type:

- a) additional domains, e.g. spacer or tag;
- b) membrane protein, e.g. M2 muscarinic receptor, olfactory receptor, CFTR, etc.; and
- c) ion channel, e.g. Kir6.2, mscL, etc.

Applicants affirm the provisional election of Group I, Claims 1-29, 34, 35, 45 and 46, with traverse, for further examination. Applicants also elect, with traverse, the following Species:

sub-species type (a) – spacer (Claims 1-3 and 5-46 read on this Species),

sub-species type (b) – MRP1 (Claims 1-4, 11-13, 15, 21-39, 42, and 44-46 read on this Species), and

sub-species type (c) – Kir6.2 (Claims 1-25 and 30-46 read on this Species).

In sum, Claims 1-3, 11-13, 15, 21-25, 30-39, 42, and 44-46 read on the combination of elected Species.

Applicants further note that as set forth on page 14 of the specification, SEQ ID NO: 1 reads on a hybrid protein having native MRP1 and Kir6.2 sequences and SEQ ID NOs: 4, 6, and 8 read on a hybrid protein having a native MRP1 sequence and a mutated Kir6.2 sequence. Therefore, the elected Species read on SEQ ID NOs: 1, 4, 6, and 8.

For sake of completion of the record and to ensure that the present response is fully responsive, Applicants restate the following traversal argument.

Applicants note that the claims of Groups II-IV depend from claims of Group I; as such, these groups are not separable.

In regard to Groups I and IV, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the hybrid product can be used in a materially different process such as the determination of the crystal structure of the protein. However, the Office has not provided reasons and/or examples to support this conclusion. Further, the Office has failed to show that the proposed process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

The Office has characterized the inventions of Groups II- IV as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the different products of Groups II and III are not necessarily used in or made by the method of Group IV.” However, the Office has not provided sufficient reasons and/or examples to support this assertion. The

Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office, particularly in view of the fact that Groups II and III are classified into the same subclass (class 536, subclass 23.1).

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Finally, Applicants remind the Examiner of MPEP §821.04

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Upon a finding of allowability of the elected product claims, Applicants respectfully request rejoinder of withdrawn process claims.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413-2220

(OSMMN 08/03)